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By: Helene Gabel

Date: December 10, 2004

MAIL STOP AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	Patent Application of Philip A. Gale <i>et al.</i>	:	Group Art Unit 1626
Conf. No.:	3407	:	
Appln. No.	09/838,998	:	Examiner: Rebecca Anderson
Filed:	April 20, 2001	:	
For:	CALIXPYRROLES	:	Attorney Docket No. 045404-1U1

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated June 10, 2004 (Paper No. 0602). This response is being timely submitted by December 10, 2004 in view of the simultaneous filing of a Petition for Extension of Time (five months).

Claims 118-140 are presently pending in the application.

In the present Office Action, the Examiner has set forth a Restriction Requirement among the following Groups of allegedly patentable distinct inventions of compositions:

Group I (claims 118-140), drawn to compositions comprising a calix[n]pyrrole macrocycle that has n pyrrole rings linked in alpha positions via sp^3 hybridized meso-carbon atoms, wherein neither non-pyrrole substituent of the meso-carbon atoms is hydrogen, and wherein n is 5 and the macrocycle is noncovalently complexed to a molecular or anionic species, allegedly classified in various subclasses of class 514;

Group II (claims 118-140), drawn to compositions comprising a calix[n]pyrrole macrocycle that has n pyrrole rings linked in alpha positions via sp^3 hybridized meso-carbon atoms, wherein neither non-pyrrole substituent of the meso-carbon atoms is hydrogen, and wherein n is 6 and the macrocycle is noncovalently complexed to a molecular or anionic species, allegedly classified in various subclasses of class 514;

Group III (claims 118-140), drawn to compositions comprising a calix[n]pyrrole macrocycle that has n pyrrole rings linked in alpha positions via sp^3 hybridized meso-carbon atoms, wherein neither non-pyrrole substituent of the meso-carbon atoms is hydrogen, and wherein n is 7 and the macrocycle is noncovalently complexed to a molecular or anionic species, allegedly classified in various subclasses of class 514;

Group IV (claims 118-140), drawn to compositions comprising a calix[n]pyrrole macrocycle that has n pyrrole rings linked in alpha positions via sp^3 hybridized meso-carbon atoms, wherein neither non-pyrrole substituent of the meso-carbon atoms is hydrogen, and wherein n is 8 and the macrocycle is noncovalently complexed to a molecular or anionic species, allegedly classified in various subclasses of class 514; and

Group V (claims 120-140), drawn to compositions comprising a calix[n]pyrrole macrocycle that has n pyrrole rings linked in alpha positions via sp^3 hybridized meso-carbon atoms, wherein neither non-pyrrole substituent of the meso-carbon atoms is hydrogen, and wherein n is 4 and the macrocycle is noncovalently complexed to a molecular or anionic species, allegedly classified in various subclasses of class 514.

The Examiner contends that the inventions in Groups I to V are related as independent and distinct products which vary materially in structure and composition, and that the level of skill in the art is not such that the invention in one group would be obvious over the other inventions. The Examiner argues that the compositions are recognized in the art as being distinct

from one another because of their diverse chemical structures, their different chemical properties, modes of action, different effects and reactive conditions. Finally, the Examiner argues that because of the plethora of classes and subclasses in each Group, a serious burden would be imposed on the Examiner to perform a complete search of the defined area.

The Examiner has further required election of a single composition in the elected Group, including an exact definition of each substitution on the base molecule (Formula (I)), in which a single member at each substituent group or moiety is selected.

Traversal of Restriction Requirement

Initially, Applicants object to the issuance of a Restriction Requirement at such a late stage in the prosecution of this application. The present application was filed in April 2001, and several Office Actions have been issued and responded to at considerable time and expense on the part of Applicants. During three years of correspondence with Examiner Robert Gerstl, other than an initial restriction requirement mailed January 28, 2002, to which a response was filed February 28, 2002, no restriction requirement was imposed on the claims substantially similar in scope to the pending claims. Indeed, all of the prior art rejections had been overcome, and there were only outstanding were formal rejections under 35 USC § 112. Now, in 2004, a new Examiner has imposed a five-way restriction requirement, effectively forcing Applicants to re-prosecute the application five times, and effectively eroding term on any result patents because of the additional prosecution required. The resultant prejudice to the applications because of the Patent Office's inconsistent restriction position relating to the subject matter of the pending claims is great.

Furthermore, the present restriction imposed by the Examiner is not proper, since a search of the compounds of one group should result in any information and prior art related to the remaining Groups I, II, IV, and V. Accordingly, reconsideration and withdrawal of the Restriction Requirement and rejoining of all the pending claims are respectfully requested.

Provisional Election

As required by 37 C.F.R. 111, Applicants hereby provisionally elect, with traverse, the invention of Group V for initial examination. Applicants further elect the composition of Structure I, in which $n = 4$, $p=q=r=s=0$; all of the odd-numbered R groups ($R_1, R_3, R_5, R_7, R_9, R_{11}, R_{13}$, and R_{15}) are methyl, all of the even-numbered R groups ($R_2, R_4, R_6, R_8, R_{10}, R_{12}, R_{14}$,

Application No. 09/838,998
Response to Office Action of June 10, 2004

and R₁₆) are hydrogen, R_A, R_B, R_C, and R_D are hydrogen, and the macrocycle is complexed to a chloride anion. This compound is prepared in Example 1 of the present application and depicted in Figure 2A. Claims 123, 125, 127, 128 and 130 read specifically on a composition comprising the provisionally elected compound.

Prompt reconsideration of the restriction requirement, examination of the claims, and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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December 8, 2004 By: Alan Nadel
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Enclosure: Petition for Extension of Time (five months)